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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,445	11/06/2000	Gilbert M. Aust	A31-2047RE	9717

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EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
	3731

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

8C

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/707,445	AUST ET AL.
	Examiner Michael Thaler	Art Unit 3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 14 July 2003 .

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-7, 10 and 11 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 1, 2 and 4 is/are allowed.

6) Claim(s) 3, 5-7, 10 and 11 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 14, 2003 has been entered.

Claims 3, 5-7, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan et al. (5,285,795). Ryan et al. show a surgical instrument comprising a stem section (the relatively rigid proximal portion of cannula 200 shown in figures 9-13) extending from a handle (at the proximal end of the stem section), cutting tool 22 including a cutter 40, hollow articulated section (the relatively flexible distal portion of cannula 200) connected with the cutting tool (when the cutting tool 22 is frictionally held therein) and the stem section, drive shaft 90, 86 including a rigid section 90 and flexible portion 86 and actuator means 212 extending through substantially the entire length of the articulated section (as seen in figures 9 and 11, for example). Alternatively, the combination of the distal portion of cannula 200 and member 78 may be considered to be the claimed "articulated section". As to claims 3 and 5, Ryan et al., in this embodiment, disclose the cutter and drive shaft as being longitudinally

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reciprocal rather than rotatable. However, it is well known in the surgical instrument art that surgical cutters within elongated tubular members may be either rotatable or longitudinally reciprocal. In fact, Ryan et al. discloses in col. 1, lines 7-15 that a related application, which is incorporated therein by reference, includes a rotary cutting blade. One of the self-evident advantages of a rotatable cutter over a longitudinally reciprocal cutter is that the cutter and drive shaft does not undergo abrupt changes in directions at each stroke which could wear out parts. It would have been obvious to make the Ryan et al. cutter and drive shaft rotatable rather than longitudinally reciprocal so that it too would have this advantage. Although Ryan et al. disclose using the actuator to bend the cannula while the probe is not present therein, and then inserting the probe into the bent cannula, the Ryan et al. apparatus, with no modification in structure, is inherently capable of being used in a different manner, i.e., by first inserting the probe into the cannula and then using actuator to bend the cannula with the probe therein. Since the claims are drawn to the apparatus rather than the method of using the apparatus, the rejection is proper. Alternatively, it certainly would have been obvious to bend the Ryan et al. cannula and probe therein by the actuator in order to fine tune the orientation of the probe in the body if the cannula and probe were not initially oriented perfectly in the body. As to claims 6 and

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7, Ryan et al., in the embodiment of figures 9-13, fail to disclose the actuator means including first and second (two) elongated elements. However, Ryan et al., in the embodiment of figures 4 and 5 teach that two diametrically opposed elongated elements 94, 96 may be used to bend the cannula body (col. 6, lines 39-61) with the advantage that the cannula can be bent in two opposite directions. It would have been obvious to include two diametrically opposed elongated elements in the cannula of the embodiment of figures 9-13 so that it too would have this advantage. As to the limitation that the elongated elements are "connected with the movable member" (in claim 6, lines 12-15, e.g.), elongated element 212 is connected with the distal portion of cannula 200. When movable member 22 is connected with the distal portion of cannula 200 by being frictionally inserted therein, the elongated element 212 is connected (at least indirectly) with movable member 22. As to claims 5, 7, 11, although the passage 48 of Ryan et al. is disclosed as being used to conduct fluid and tissue from the cutter to the handle, this passage, with no modification, is inherently capable of conducting fluid in the opposite direction, from the handle towards the cutter by, for example, connecting the proximal end of the passage to a source of irrigating fluid. Since the source of irrigating fluid is not part of the claimed combination, it is not necessary for the prior art to show this feature. As to claims 10 and 11, the Ryan et al. specification fails to

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specifically indicate that elongated element 212 is "connected to" movable member 22. However, it would have been obvious that elongated element 212 is connected to movable member 22 for the reasons set forth above.

Claims 1, 2 and 4 are allowed.

Applicant's arguments filed July 14, 2003 have been fully considered but they are not persuasive. Although the embodiment of figures 4-5 of Ryan et al. fails to show actuator means 94, 96 extending through substantially the entire length of the articulated section 102, this feature is disclosed in the embodiment of figures 9-13. The argument on page 9 of the response that rotatable cutters also reciprocate about an axis is not persuasive since many surgical rotatable cutters rotate in one direction only and thus do not reciprocate about the axis of rotation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are

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(703)305-3590 for regular communications and (703)305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht  
July 30, 2003



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731